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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,815	03/13/2001	Scott G. Newnam	109.779.129	2040
23483 7590 03/01/2007 WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			EXAMINER SWEARINGEN, JEFFREY R	
			ART UNIT	PAPER NUMBER
			2145	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		03/01/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

teresa.carvalho@wilmerhale.com  
tina.dougal@wilmerhale.com  
michael.mathewson@wilmerhale.com

# Office Action Summary

Application No.

09/804,815

Applicant(s)

NEWNAM ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 36-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 46-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/10/2006 has been entered.

### ***Election/Restrictions***

2. Claims 36-45 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/10/2006.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-35 and 46-52 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

4. Claim 27 is objected to because of the following informalities: In the second wherein clause, there is a grammatical error "staffed by an individual that can providing responses to users via the server." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 26-29, and 31-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claims 26-29 and 31-32, Applicant is

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apparently claiming a human being, as a "technical director", as being part of the method.

Applicant is not allowed to claim human beings. See MPEP 2105.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-35 and 46-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Roberts et al. (U.S. 5,987,525).

9. In regard to claims 1, 17, 46, 49, Roberts disclosed:

*receiving client software for a client to operate on a user-based hardware device that has the ability to control a display, [compiled code downloaded by a browser from a web page as a plug-in, column 3, lines 15-60] the client software including:*

*base software for causing information to be displayed on the display and including software responsive to messages relating to different types of interactivity, [The command plug-in of columns 3-4]*

*program content particular to multiple episodes of an event, [multiple tracks of a CD, information regarding the CD, column 4, lines 5-9] and*

*episode content particular to an episode of the event, the receiving of program content and the episode content occurring by downloading before the beginning of an episode, the episode content including components for later display during an episode and being received by the client before the beginning of the episode, the components being displayed during the program in accordance with predetermined times and/or in response to messages from the server; [column 4, lines 51-67]*

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*during the episode the client receiving from the server messages indicating the selected ones of the previously stored interactive components related to the episode of the event; [column 4, lines 51-67] and*

*the base software responsive to the message for causing to be displayed on the display the indicated stored interactive component in a form particular to the type of interactivity, wherein the interactive components include one or more facts, trivia questions, and poll questions [column 6, lines 30-54; column 7, lines 34-60].*

10. In regard to claims 2, 18, Roberts disclosed:

*for a next episode, receiving new episode content with components related to the next episode prior to the beginning of the next episode without again receiving the program content and the base software. [column 4, lines 51-67]*

11. In regard to claims 3, 19, Roberts disclosed:

*for an episode of a different program, receiving the program content and the episode content without again receiving the base software prior to the beginning of the episode of the different program, and using the base software with the program content and episode content for the episode of the different program. [column 4, lines 51-67]*

12. In regard to claims 4, 20, Roberts disclosed:

*wherein the program content relates to a television program, and the episode content is for a particular episode of that television program. [see video clips in column 6, line 37]*

13. In regard to claims 5, 21, Roberts disclosed:

*wherein at least two of the types of interactive components include a question to which a user can respond. [column 7, lines 34-60]*

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14. In regard to claims 6, 22, Roberts disclosed:

*wherein the interactive components include a trivia question and a poll. [column 7, lines 34-60. The voting procedures are trivia questions and polls.]*

15. In regard to claims 7, Roberts disclosed:

*wherein the message includes an indication that the message is for a trivia question, and includes text for the trivia question, the base software being responsive to the indication that the message is a trivia question for formatting the question as a trivia question and for displaying the trivia question with the format. [column 7, lines 34-60]*

16. In regard to claim 8, Roberts disclosed:

*wherein the formatting further includes displaying a point count for the question that changes with time. [a higher number is used in response to the voting mechanism in column 7, lines 50-54]*

17. In regard to claim 9, Roberts disclosed:

*wherein the base software, responsive to a user entering an answer, causes the answer to be provided to the server to determine if it is correct. [column 7, lines 34-44. The user takes actions, which in turn causes the server to take appropriate actions based on the change indicated in the user's message.]*

18. In regard to claim 10, Roberts disclosed:

*wherein the base software, responsive to a user entering an answer, checks the answer against an answer stored as part of the episode content. [column 7, lines 34-44]*

19. In regard to claims 11, 23, Roberts disclosed:

*wherein one of the client and server corrects the answer, the client receiving from the server and displaying a point total for multiple users interacting at the same time with*

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*the server. [a higher number is used in response to the voting mechanism in column 7, lines 50-54]*

20. In regard to claims 12, 24, Roberts disclosed:

*wherein the client is presentation layer independent. [The client uses Shockwave, JavaScript, and VBScript, which are considered presentation layer independent. Column 3, lines 27-60]*

21. In regard to claims 13, 25, Roberts disclosed:

*wherein the client operates with a particular type of presentation software.*  
[column 3, lines 27-60]

22. In regard to claim 14, Roberts disclosed:

*the client sending messages from the user to the server and receiving messages from other users via the server in a chat functionality during the episode of the program.*  
[column 6, lines 56-59]

23. In regard to claim 15, Roberts disclosed:

*the episode content includes a plurality of advertisements, the base software being responsive to messages for causing one of the advertisements to be displayed.*  
[column 2, lines 8-20, where an advertisement is "complimentary entertainment for musical recordings"]

24. In regard to claims 16, 34, Roberts disclosed:

*the client is responsive to the receipt of a message and audio and/or video information for synchronizing the audio and/or video information to the type of interactivity indicated by the message. [column 5, lines 3-20]*

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25. In regard to claim 26, Roberts disclosed:

*a technical director for managing the server and providing messages to and receiving messages from the server. [Any server inherently has a server administrator. This is also arguable as the software managing the server in column 7, lines 34-54.]*

26. In regard to claim 27, Roberts disclosed:

*the server provides messages received from users to the technical director during the episode, wherein the technical director is staffed by an individual that can providing responses to users via the server. [column 7, lines 34-54]*

27. In regard to claim 28, Roberts disclosed:

*wherein at least some questions for responses are initiated from the technical director to the server, and thereafter to the users on-the-fly during the episode. [column 7, lines 34-54]*

28. In regard to claim 29, Roberts disclosed:

*wherein the program is a television program, wherein the technical director provides content to the server for transmission to the users, the content being stored and timed to be received by the user in such a way that the content is synchronized to the television program to display content relevant to the program at that time. [column 5, lines 1-20]*

29. In regard to claim 30, Roberts disclosed:

*wherein the content is provided to be stored in advance of being displayed and is timed to appear at selected times. [column 5, lines 1-20]*

30. In regard to claim 31, Roberts disclosed:



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*wherein the technical director receives content as a human input and provides that content on the fly as a supplement to the content provided to be stored in advance.*

[column 7, lines 34-54]

31. In regard to claim 32, Roberts disclosed:

*the technical director receives content as a human input and provides that content on the fly to appear at a desired time such that it is relevant to the program at that time.* [column 5, lines 1-20]

32. In regard to claim 33, Roberts disclosed:

*the episode content includes a plurality of advertisements for client storage, the server sending messages to indicate to the client that the client should cause one of the stored advertisements to be displayed.* [column 2, lines 8-20, where an advertisement is "complimentary entertainment for musical recordings"]

33. In regard to claim 35, Roberts disclosed:

*messages can be provided to thousands of users at the same time.* [column 6, lines 60-67, where an IRC chat room is used to send information to all clients in the chat room.]

34. In regard to claims 47, 50, Roberts disclosed:

*receiving additional content on-the-fly for display during the broadcast.* [column 5, lines 3-20]

35. In regard to claim 48, Roberts disclosed:

*prior to a plurality of episodes, receiving common content related to the plurality of episodes, and prior to each episode, downloading content particular to that episode.*  
[column 4, lines 52-67]

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36. In regard to claim 51, Roberts disclosed:

*at least one of the interactive components is displayed based on predetermined times during the episode.* [column 5, lines 3-20]

37. In regard to claim 52, Roberts disclosed:

*further interactive components are received and displayed on-the-fly.* [column 7, lines 34-67]

### **Conclusion**

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

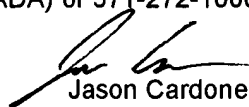
Ogdon et al.	US 6,161,137
Barnert et al.	US 6,239,793 B1
McNeill et al.	US 6,421,706 B1
Parasnis et al.	US 6,728,753 B1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Cardone  
Supervisory Patent Examiner  
Art Unit 2145